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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/397,225	03/28/95	PERRICAUDET	M EX93015G1-US

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EXAMINER

PRIEBE, S

ART UNIT	PAPER NUMBER
1632	25

DATE MAILED: 11/20/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/397,225

Applicant(s)  
Perricaudet et al.

Examiner  
Scott D. Priebe, Ph.D.

Group Art Unit  
1632



☒ Responsive to communication(s) filed on Nov 2, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-3, 6, and 9-41 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 1-3, 6, 9-30, and 33-40 is/are allowed.

☒ Claim(s) 31, 32, and 41 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 61/2 & 19

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

The amendment filed 11/2/98 has been entered. Claims 1-3, 6, 9-39 have been amended and claims 40 and 41 added. Claims 1-3, 6, 9-41 are pending.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 41 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 41 recites "an E1A promoter, a MLP promoter, a CMV promoter and an RSV promoter". The abbreviations are vague since an abbreviation may have more than one meaning. In the case of the first two --an adenoviral-- should be inserted in place of "an" or "a" respectively. The working examples (e.g. page 17) show that "RSV promoter" is to mean --Rous sarcoma virus LTR promoter--, which should replace "RSV promoter". In the case of "CMV", this abbreviation has not been defined in the specification, and could be interpreted as at least cytomegalovirus or cucumber mosaic virus. It is suggested that "a CMV promoter" be deleted, as it is unclear that there is support in the specification for defining the abbreviation.

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***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 31-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Gregory et al., US 5,670,488 for the reasons of record applied against claims 1, 3, 6, 9, 10, 12-14, 17-19, 23, 27-32, 36 and 37 in the Office action of 4/28/98.

Applicant's arguments filed 11/2/98 have been fully considered but they are not persuasive. The amendment to the claim is insufficient to avoid anticipation by the PAV of Gregory et al., which consists of ITR sequences, an encapsulation sequence, and a heterologous DNA. The PAV vector has deletions inactivating E3, E4 and L1-L5 genes, as well as all other adenoviral coding sequences. The claim does not preclude that all coding sequences, including E3, E4 and L1-L5, are deleted. In order for these claims to be distinguished from the PAV, claim 31 must recite what coding sequences are present, as well as what is absent.

***Allowable Subject Matter***

Claims 1-3, 6, 9-30, 33-40 are allowed. Claim 41 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2<sup>nd</sup> paragraph, set forth in this Office action.

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*Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Certain papers related to this application may be submitted to Art Unit 1632 by facsimile transmission. The FAX number is (703) 308-4242 or 305-3014. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. **NO DUPLICATE COPIES SHOULD BE SUBMITTED**, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott D. Priebe whose telephone number is (703) 308-7310. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM. If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's supervisor, Brian Stanton, Ph.D., can be reached on (703) 308-2801.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

SDP

Scott D. Priebe, Ph.D.  
Patent Examiner  
Art Unit 1632



BRUCE R. CAMPELL  
PRIMARY EXAMINER  
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